UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,623	09/16/2005	Toshiyasu Yabe	9683/216	2703

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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	**Applicant(s)**
Office Action Summary	10/517,623	YABE ET AL.
	Examiner	**Art Unit**	
	Hee Soo Kim	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _____ .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-12* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8/7/2007, 2/9/2007, 8/28/2006, 09/13/2005.

DETAILED ACTION

This action is responsive to application filed on September 16, 2005. Claims 1~12 are pending examination.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 09/13/2005, 08/28/2006, 02/09/2007, 08/07/2007 were filed after the mailing date of 12/06/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Inventorship

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Objections

Claims 1 is objected to because of the following informalities:

- There is a misspelled word "sever".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1~12 are rejected under 35 U.S.C. 103(a) as being unpatentable by

Takushi (JP11272582A) in view of Beyda et al. hereinafter Beyda (US 6,275,850).

Regarding Claim 1,

Takushi taught an e-mail distribution method for sending e-mail with attachment

files from a server apparatus to a communications terminal, the method comprising:

a sending step of sending the type information to said server apparatus from the

communications terminal (Par. [0016]~[0018], [0021]);

a receiving step of receiving the type information in the server apparatus (Par.

[0016]~[0018], [0021]);

a step of determining, at the server apparatus, whether a type of an attachment file of e-mail, which is destined for the communications terminal and received by the server apparatus, is identical to a type identified by the type information (Par. [0039]~[0042], Fig. 1, the e-mail acquisition restriction function compares the email file format with table for compliance), and

a step of sending from the server apparatus to the communications terminal e-mail from which the attachment file is deleted, when the type of the attachment file of the e-mail is not identical to the type identified by the type information, and transferring the e-mail from the server apparatus to the communications terminal, when the type of the attachment file of the e-mail is identical to the type identified by the type information (Par. [0039]~[0042], Fig. 1, if the e-mail acquisition restriction function detects an e-mail with attachment containing a file format not matching with table, the e-mail is sent to the PDA without the attachment).

Takushi's invention teaches the type of attachment file received by the communication terminal is based on the terminal's capabilities. The claimed feature of the server obtaining information identifying the type of attachment file a user of the communications terminal desires to receive is not taught. However, Beyda taught a method and a system to transfer selected attached files to a client device depending upon the personal preference of the user (Abstract). More specifically, the attachment filter can be configured to only allow files in certain formats to be auto-downloaded (Col. 6, Lines 50~62). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both inventions to allow attachment files

to be sent from the server to the terminal based on its capabilities and user preferences. The combination allows the system to accommodate all aspects of e-mail management known in the art.

Regarding Claim 2,
Beyda further taught a step of sending from the communications terminal to the server apparatus a request for obtaining e-mail destined for the communications terminal, the request including the type information obtained by the communications terminal (Col. 4, Lines 36~45, client devices are configured to automatically download attached files only if the attributes of the email messages and their attachments satisfy a prescribed requirement).

Regarding Claim 3,
Takushi and Beyda both did not explicitly disclose the communications terminal displays types of available files used in the communications terminal. "Official Notice" is taken that the ability to display different types of files such as text, images, sound, etc., by the communications terminal and according to the user's preferences is well-known and expected in the art. Therefore it would have been obvious for the communications terminal to display different types of available files used to determine whether the capabilities of the terminal device would allow such attachment files to be viewed.

Regarding Claim 4,
Beyda taught the communications terminal further includes detachable memory, and the method further comprising a storing step of receiving at the communications terminal e-mail transmitted in said sending step and storing the attachment file of the received e-mail in said memory (Col. 5, Lines 1~14, the attachment filter determine which attached files are to be downloaded from the local server to the memory of the

client device. Beyda's invention does not utilize <u>detachable</u> memory however, the fact

the attachment file can be saved in a memory doesn't make it any difference whether it

is detachable or not).

Regarding Claim 5,
Beyda further taught the attachment filter may also have a default setting that

may include one or more user preference or criteria. This implies the default setting

allows all e-mails to be received regardless of the attachment types. One of ordinary

skill in the art would obviously then set up the filtering hereon forth disallowing certain

attachment types to be downloaded to the device based on the default setting.

Regarding Claim 6,
Takushi further taught a communications terminal comprising:

a transmitting means for transmitting the type information to a server apparatus

(Par. [0016]~[0018], [0021]); and

a receiving means for receiving e-mail from the server apparatus (Par.

[0016]~[0018], [0021]).

Takushi's invention teaches the type of attachment file received by the

communication terminal is based on the terminal's capabilities. The claimed feature of

the server obtaining information identifying the type of attachment file a user of the

communications terminal desires to receive is not taught. However, Beyda taught a

method and a system to transfer selected attached files to a client device depending

upon the personal preference of the user (Abstract). More specifically, the attachment

filter can be configured to only allow files in certain formats to be auto-downloaded (Col.

6, Lines 50~62). Therefore it would have been obvious to one of ordinary skill in the art

at the time the invention was made to combine both inventions to allow attachment files

to be sent from the server to the terminal based on its capabilities and user preferences.

The combination allows the system to accommodate all aspects of e-mail management

known in the art.

Regarding Claim 7,
Beyda further taught comprising means for transmitting to the server apparatus a

request for obtaining e-mail destined for the communications terminal, the request

including the type information obtained by the communications terminal (Col. 4, Lines

36~45, client devices are configured to automatically download attached files only if the

attributes of the email messages and their attachments satisfy a prescribed

requirement).

Regarding Claim 8,
Takushi and Beyda both did not explicitly disclose the communications terminal

displays types of available files used in the communications terminal. "Official Notice" is

taken that the ability to display different types of files such as text, images, sound, etc.,

by the communications terminal and according to the user's preferences is well known

and expected in the art. Therefore it would have been obvious for the communications

terminal to display different types of available files used to determine whether the

capabilities of the terminal device would allow such attachment files to be viewed.

Regarding Claim 9,
Beyda further taught comprising means for storing an attachment file of a

received e-mail to a detachable memory (Col. 5, Lines 1~14, the attachment filter

determine which attached files are to be downloaded from the local server to the

memory of the client device. Beyda's invention does not utilize detachable memory

however, the fact the attachment file can be saved in a memory doesn't make it any difference whether it is detachable or not).

Regarding Claim 10,
Beyda further taught the attachment filter may also have a default setting that may include one or more user preference or criteria. This implies the default setting allows all e-mails to be received regardless of the attachment types. One of ordinary skill in the art would obviously then set up the filtering hereon forth disallowing certain attachment types to be downloaded to the device based on the default setting.

Regarding Claim 11,
Takushi further taught a server apparatus comprising:

means for determining whether a type of an attachment file of e-mail, which is destined for the communications terminal and received by the server apparatus, is identical to a type identified by the type information (Par. [0039]~[0042], Fig. 1, the e-mail acquisition restriction function compares the email file format with table for compliance); and

means for sending to the communications terminal e-mail from which the attachment file is deleted, when the type of the attachment file of the e-mail is not identical to the type identified by the type information, and transferring the e-mail to the communications terminal, when the type of the attachment file of the e-mail is identical to the type identified by the type information (Par. [0039]~[0042], Fig. 1, if the e-mail acquisition restriction function detects an e-mail with attachment containing a file format not matching with table, the e-mail is sent to the PDA without the attachment).

Takushi's invention teaches the type of attachment file received by the communication terminal is based on the terminal's capabilities. The claimed feature of the server obtaining information identifying the type of attachment file a user of the communications terminal desires to receive is not taught. However, Beyda taught a method and a system to transfer selected attached files to a client device depending upon the personal preference of the user (Abstract). More specifically, the attachment filter can be configured to only allow files in certain formats to be auto-downloaded (Col. 6, Lines 50~62). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both inventions to allow attachment files to be sent from the server to the terminal based on its capabilities and user preferences. The combination allows the system to accommodate all aspects of e-mail management known in the art.

Regarding Claim 12,
Takushi further taught an e-mail distribution method adapted to a server apparatus for sending to a communications terminal, the method comprising the steps of:

upon receipt of e-mail destined for the communications terminal, determining whether a type of an attachment file of the e-mail is identical to a type identified by the type information (Par. [0039]~[0042], Fig. 1, the e-mail acquisition restriction function compares the email file format with table for compliance); and

sending to the communications terminal e-mail from which the attachment file is deleted, when the type of the attachment file of the e-mail is not identical to the type identified by the type information, and transferring the e-mail to the communications

terminal, when the type of the attachment file of the e-mail is identical to the type identified by the type information (Par. [0039]~[0042], Fig. 1, if the e-mail acquisition restriction function detects an e-mail with attachment containing a file format not matching with table, the e-mail is sent to the PDA without the attachment).

Takushi's invention teaches the type of attachment file received by the communication terminal is based on the terminal's capabilities. The claimed feature of the server obtaining information identifying the type of attachment file a user of the communications terminal desires to receive is not taught. However, Beyda taught a method and a system to transfer selected attached files to a client device depending upon the personal preference of the user (Abstract). More specifically, the attachment filter can be configured to only allow files in certain formats to be auto-downloaded (Col. 6, Lines 50~62). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine both inventions to allow attachment files to be sent from the server to the terminal based on its capabilities and user preferences. The combination allows the system to accommodate all aspects of e-mail management known in the art.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing

responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hee Soo Kim whose telephone number is (571) 270-3229. The examiner can normally be reached on Monday - Friday 7:30AM - 5PM EST.
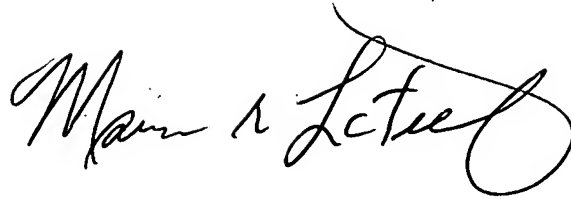
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on (571) 272-5026. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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9/10/07

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MARVIN LATEEF
SUPERVISORY PATENT EXAMINER